

REMARKS

I. STATUS OF APPLICATION

Claims 1-20 are currently pending in the present Application. No claims have been added, amended, or canceled.

Claims 1-4, 6-12, and 14 stand rejected under 35 USC § 103(a), as being unpatentable over Applicant's Admitted Prior Art ("AAPA") in view of U.S. Patent 5,248,119 to Imura ("Imura").

Claims 4, 13, and 15-20 stand rejected under 35 USC § 103(a), as being unpatentable over AAPA in view of Imura and U.S. Patent 3,710,674 to Tabor ("Tabor").

II. 35 USC § 103 REJECTIONS

In the consideration and determination of obviousness under 35 U.S.C. 103, the four factual inquiries¹ used as a background for determining obviousness are (1) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims in issue; (3) resolving the level of ordinary skill in the pertinent art; and (4) evaluating evidence of secondary considerations. In determining the differences between the prior art and the claims, the question under 35 USC § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.² A prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed

¹ See *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).

² *MPEP 2141.02*, citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983).

invention.³ The U.S. Supreme Court reinforces this principle in its decision in *KSR Int'l. Co. v. Teleflex, Inc.*,⁴ stating that “when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.”⁵

It is legally insufficient to conclude that a claim is obvious “merely by demonstrating that each of its elements was, independently, known in the prior art.”⁶ When the claimed invention is not a “predictable use of prior art elements according to their established functions,” the claimed invention cannot be found to be obvious.⁷ For example, when the elements of the claimed invention work together “in an unexpected and fruitful manner,” the claimed invention was not obvious to one skilled in the art at the time of the invention.⁸ Moreover, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”⁹ The Office must “identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.”¹⁰ The Office must also make “explicit” this rationale of “the apparent reason to combine the known elements in the fashion claimed,” including a detailed explanation of “the effects of demands known to the design community or present in the marketplace” and “the background knowledge

³ *MPEP 2141.02*, citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

⁴ *KSR Int'l. Co. v. Teleflex, Inc.*, 550 U.S. ____ (2007).

⁵ *KSR*, slip op. at 12, citing *United States v. Adams*, 383 U.S. 39, 40 (1966).

⁶ *KSR*, slip op. at 14.

⁷ *KSR*, slip op. at 13.

⁸ *KSR*, slip op. at 12.

⁹ *KSR*, slip op. at 14, citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006).

¹⁰ *KSR*, slip op. at 15.

possessed by a person having ordinary skill in the art.”¹¹ Anything less than such an explicit analysis is insufficient to support a *prima facie* case of obviousness. Such an analysis must not “read into the prior art the teachings of the invention in issue” and must “guard against slipping into the use of hindsight.”¹²

A. Claims 1-4, 6-12, and 14 are not obvious over AAPA and Imura

Claims 1-4, 6-12, and 14 stand rejected under 35 USC § 103(a), as being unpatentable over AAPA in view of Imura. Applicant respectfully traverses the rejection because neither AAPA nor Imura render the claimed invention obvious for at least the reasons set forth *infra*.

Independent claim 1, from which claims 2-4 and 6-10 depend, recites “an anti-friction insert member.” Independent claim 11, from which claims 12 and 14 depend, also recites “an anti-friction member.”

The Office admits on the record that AAPA fails to disclose the claimed anti-friction insert member but relies upon Imura to teach the anti-friction insert member.¹³ In response to Applicant’s remarks in traverse of a previous, corresponding rejection,¹⁴ the Office alleges that Imura’s statement that:

“(4) is a resinous or rubber elastic member” within column 3, line 10 by Imura provides all of the proof or statement needed to meet the applicant’s limitation of anti-friction characteristics since it is well known and conventional in the art that “rubber” provides anti-friction characteristics inherently as supported by the disclosure of Acker et al.

¹¹ *KSR*, slip op. at 14.

¹² *KSR*, slip op. at 17.

¹³ Detailed Action, p. 2, l. 21, through p. 3, l. 1.

¹⁴ See Applicant’s Response to Office Action, dated 3 January 2006, p. 9, l. 14, through p. 14, l. 11, which are incorporated herein by reference.

column 4, line 36ff that “for such rubber-elastic material to bear anti-friction coatings.”¹⁵

While not specifically noted in the Detailed Action, Applicant believes the Office’s reference to “Acker” corresponds to U.S. Patent 6,393,965 to Acker *et al.* (“Acker”), which is listed in the Notice of References Cited accompanying the present Office Action.

First, Applicant respectfully traverses the Office’s assertion that “‘rubber’ provides anti-friction characteristics inherently.” If the Office’s allegation were factual in a generic sense, rubber would not be the material of choice for vehicle tires, as locomotion is only achieved as a result of friction between the vehicle’s tires and the surface over which the vehicle is traveling. If the Examiner wishes to maintain the allegation that “‘rubber’ provides anti-friction characteristics inherently,” Applicant respectfully requests an affidavit executed by the Examiner attesting to the Examiner’s position.

Second, Applicant respectfully asserts that the Office has fundamentally misconstrued the teachings of Acker. In the portion of Acker cited by the Office, Acker describes rubber-elastic materials that have anti-friction coatings applied to them. Therefore, it is not the rubber material that exhibits any anti-friction characteristics but the coating applied to the rubber material that is anti-friction in nature. Thus, even if the Office’s allegation were reasonable that “‘rubber’ provides anti-friction characteristics inherently,” Acker would not be evidence of such. Rather, Applicant respectfully submits that one of ordinary skill in the art would appreciate that Acker actually provides evidence that “rubber-elastic materials” do not have anti-friction characteristics, because

¹⁵ Detailed Action, p. 5, ll. 1-8.

Acker teaches that “anti-friction coatings” are applied to “rubber-elastic materials,” “with a view to as favourable friction coefficients as possible.”¹⁶

With these issues addressed, attention is drawn back to Imura. Imura is silent with regard to its member 4 having any anti-friction characteristics. Rather, Imura teaches that its member 4 “is a resinous or rubber elastic member...being fitted or bonded to the seizing walls (3, 3') or the outer peripheral surface of the pipe (P) as the necessity arises.”¹⁷ Applicant respectfully asserts that a person having ordinary skill in the art at the time of the invention would have appreciated that Imura's member 4 frictionally grips the pipe P, rather than having any anti-friction properties, as required by the claimed anti-friction insert member set forth in claim 1.

If one of ordinary skill in the art were to modify Imura such that its member 4 were to be anti-friction in nature, Applicant respectfully asserts that Imura's device would not operate as intended. Because Imura's member 4 frictionally grips pipe P, modifying member 4 to be anti-friction in nature would prevent or at least inhibit the capability of member 4 to frictionally grip pipe P. Where a modification or combination renders a prior art reference inoperable for its intended purpose, the reference teaches away from the modification or combination.¹⁸ It is by now well established that teaching away by the prior art constitutes *prima facie* evidence that the claimed invention is not obvious.¹⁹

¹⁶ Acker, col. 4, ll. 34-36.

¹⁷ Imura, col. 3, ll. 9-14.

¹⁸ *In re Gordon*, 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984).

¹⁹ See, *inter alia*, *In re Fine*, 5 U.S.P.Q.2d (BNA) 1596, 1599 (Fed. Cir. 1988); *In re Nielson*, 2 U.S.P.Q.2d (BNA) 1525, 1528 (Fed. Cir. 1987); *In re Hedges*, 228 U.S.P.Q. (BNA) 685, 687 (Fed. Cir. 1986).

Accordingly, claim 1 and 11, as well as the claims dependent thereto, are allowable over AAPA in view of Imura because Imura fails to teach the claimed anti-friction insert member, even in light of the teachings of Acker, and, in fact, teaches away from the claimed anti-friction member because the inclusion of such a member in Imura would render Imura inoperable for its intended purpose.

Moreover, independent claim 1, from which claims 2-4 and 6-10 depend, recites “the flanges preventing axial movement of the insert member relative to the finger members.” Although the present Office Action indicates “Applicant’s arguments with respect to claims including flanges preventing axial movement of the insert member relative to the finger members have been considered but are moot in view of the new ground(s) of rejection,”²⁰ this aspect of the present rejection directly corresponds to the rejection proffered by the Office in its Office Action of 4 October 2005.²¹

In all of Imura’s drawings in which member 4 is depicted,²² each of the flanges of member 4 are spaced apart from seizing walls 3, 3’. Thus, the flanges of member 4 cannot prevent axial movement of member 4 relative to seizing walls 3, 3’. Furthermore, Imura is silent with regard to any suggestion that the flanges of member 4 prevent axial movement of member 4 relative to seizing walls 3, 3’ or to any suggestion that it would be even desirable for the flanges of member 4 to prevent axial movement of member 4 relative to seizing walls 3, 3’. Accordingly, a person having ordinary skill in the art at the time of the invention would not have appreciated that the flanges of Imura’s member 4 could perform the function of preventing axial movement of an insert

²⁰ Detailed Action, p. 5, ll. 9-12.

²¹ See Office Action of 4 October 2005, pp. 2-3.

²² See Imura, Figures 1, 2A, and 2B.

member relative to finger members, as required by claim 1 and the claims dependent thereto.

For at least the reasons provided *supra*, claims 1-4, 6-12, and 14 cannot be rendered obvious in light of AAPA and Imura, even taking into account the teachings of Acker. Accordingly, it is respectfully requested that the rejection of claims 1-4, 6-12, and 14 under 35 USC § 103(a), as being unpatentable over AAPA in view of Imura, be reconsidered and withdrawn.

B. Claims 5, 13, and 15-20 are not obvious over AAPA in view of Imura and Tabor

Claims 5, 13, and 15-20 stand rejected under 35 USC § 103(a), as being unpatentable over AAPA in view of Imura and Tabor. Applicant respectfully traverses this rejection for at least the reasons set forth *infra*.

Claim 5 depends from independent claim 1 and claim 13 depends from independent claim 11. Accordingly, each of claims 5 and 13 recite “an anti-friction insert member.” Independent claim 15, from which claims 16-20 depend, also recites “an anti-friction insert member.”

The Office relies upon Imura to teach this limitation,²³ as the Office has admitted on the record that AAPA fails to disclose the limitation. However, as discussed *supra* concerning the 35 USC § 103(a) rejection of claims 1-4, 6-12, and 14, Imura fails to disclose the limitation and, in fact, teaches away from the limitation. Accordingly, Imura cannot render the present invention, as set forth in claims 5, 13, and 15-20, obvious.

²³ Detailed Action, p. 4, ll. 4-7 (“Applicant’s admitted prior art figures 1A and 1B in view of Imura discloses all of the limitations of the claimed invention except for the flanges abutting the finger members.”).

It is, therefore, respectfully requested that the rejection of claims 5, 13, and 15-20 under 35 USC § 103(a), as being unpatentable over AAPA in view of Imura and Tabor, be reconsidered and withdrawn.

III. OTHER DISTINCTIONS MAY EXIST

Note that Applicant has merely discussed example distinctions from the various references cited by the Office. Other distinctions and/or arguments may exist and Applicant reserves the right to discuss these additional distinctions and/or arguments in a future Response or on Appeal. By not responding to the additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The remarks provided above are sufficient to overcome the Office's rejections.

CONCLUSION

Wherefore, in view of the foregoing remarks, this application is considered to be in condition for allowance, and an early reconsideration and issuance of a Notice of Allowance are earnestly solicited. The Examiner is invited to contact the undersigned at (817) 447-9955 with any questions, comments, or suggestions relating to the referenced patent application.

Respectfully submitted,

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Date

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